

WILMER CUTLER PICKERING
HALE AND DORR LLP

Plw



Maria L. Maebius

THE WILLARD OFFICE BUILDING
1455 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004
+1 202 942 8452
+1 202 942 8484 fax
maria.maebius@wilmerhale.com

July 30, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Applicant: CHITTENDEN et al.
Serial No.: 09/828,870
Filed: April 10, 2001
Entitled: NOVEL PEPTIDES AND COMPOSITIONS WHICH
MODULATE APOPTOSIS
Our Ref.: 104322.147US5

Dear Sir:

Enclosed herewith for appropriate action by the United States Patent and Trademark Office are the following documents:

1. Transmittal Letter;
2. Response to Restriction Requirement; and
3. Postcard evidencing the same.

Respectfully submitted,

Bethany Four Reg. No. 53,212
for Maria L. Maebius
Registration No. 42,967
Attorney for Applicants



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Atty. Docket No.: 104322.147US5
Thomas D. CHITTENDEN et al.)
Serial No.: 09/828,870) Group Art Unit: 1635
Filed: April 10, 2001) Examiner: K. LACOURCIERE
)

For: **NOVEL PEPTIDES AND COMPOSITIONS WHICH MODULATE
APOPTOSIS**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement mailed July 1, 2004, Applicants provisionally elect Group I with traverse. Moreover, applicants further elect SEQ ID NO: 36, with traverse, to be examined as the species of Group I.

Applicants respectfully submit that the restriction requirement is improper. A restriction requirement is proper when (1) the inventions are independent and distinct as claimed, 35 U.S.C. § 121; and (2) there is a serious burden on the Examiner (MPEP §803, emphasis added). Applicants respectfully submit that there is no serious burden on the Examiner to examine Groups I and II together. Group I is drawn to a method of identifying an agent that modulates GD domain mediated heterodimerization. Group II is drawn to a method of identifying an agent that modulates GD domain mediated homodimerization. It is believed that the Examiner's search of prior art of interest with

respect to the patentability of the claims of Group I, directed to a method of identifying an agent that modulates GD domain mediated heterodimerization, would also provide the Examiner with the information required to assess the patentability of claims directed to a method of identifying an agent that modulates GD domain mediated homodimerization. For example, the methods of Groups I and II utilize the same types of high through-put screening assays to identify compounds that modulate the protein binding function of the GD domain. Furthermore, the claims of Groups I and II are classified in the same field of search. Accordingly, Applicants respectfully submit that the examination of Groups I and II together would not pose a serious burden on the Examiner and reconsideration of the restriction requirement is, therefore, requested.

Moreover, Applicants have elected the examination of the species, SEQ ID NO: 36. MPEP 803.02 states the following:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions.

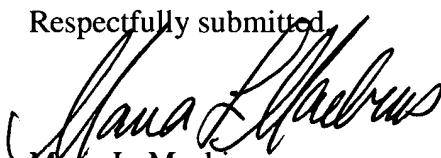
[Emphasis supplied.]

Applicants respectfully submit that it would not require a serious burden on the Examiner to examine each of SEQ ID NOS: 35-41 together. Nevertheless, upon the finding that the elected species is allowable over the prior art, Applicants acknowledge that, under MPEP 803.02, examination would be extended to the additional non-elected species.

Conclusion

Although no fee is believed to be due at this time, the Commissioner is authorized to deduct any fee that may be necessary to maintain the pendency of this application from PTO Deposit Account No. 08-0219. Should there be any questions, the undersigned can be contacted at the below-listed telephone number.

Respectfully submitted,



Maria L. Maebius
Registration No. 42,967
Attorney for Applicants

Date: 30 July 2004
Wilmer Cutler Pickering Hale and Dorr LLP
1455 Pennsylvania Avenue, NW
Washington, DC 20004
202-942-8452 (telephone)
202-942-8484 (facsimile)